

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Thomas Jozefiak, Stephen Randall Holmes-Farley, W. Harry
Mandeville, III, Chad Cori Huval, Venkata R. Garigapati, Keith K.
Shackett and Danny Concagh

Application No.: 09/721,291 Group Art Unit: 1617
Filed: November 22, 2000 Examiner: Wang, S.
Confirmation No.: 5051
For: FAT-BINDING POLYMERS

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PETITION UNDER 37 C.F.R. § 1.144

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Sir:

On January 9, 2002, Applicants filed a Response to Restriction Requirement in the above-identified patent application, in which a traversal of the restriction requirement with respect to the claims of Group VI (Claims 49-55 and 76) was made. On June 19, 2002, the traversal was denied and the restriction requirement was made final by the Patent Office. Applicants hereby petition to obtain review of the Examiner's decision to maintain the Restriction Requirement.

Applicants note that Claims 49-55 and 76 were mistakenly cancelled in the Amendment filed November 19, 2002. Applicants regret the error and any confusion resulting therefrom.

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Applicants have resubmitted claims corresponding to the claims of Group VI in the Amendment After Final being filed concurrently herewith.

In the Office Action mailed June 19, 2002, the Examiner stated that the traversal was not found persuasive because polymers of Group V have the dihydroxypropyl group, whereas the polymers of Group VI have alkyl groups or hydrogen. The Examiner concluded that the polymers are structurally distinct from each other.

The Examiner has not responded to the issue that all polymers in Groups V and VI have a core structure (shown below), so that there is no additional search burden to examine claims of both groups. The MPEP unambiguously states that an examiner must search the entire claim set under these circumstances:

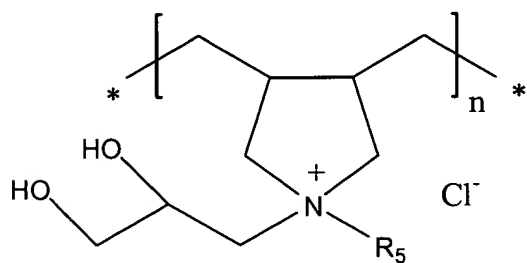
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.

Given that the polymers of Groups V and VI are all fat-binding polymers, the inventions are also related. On this point, the MPEP states:

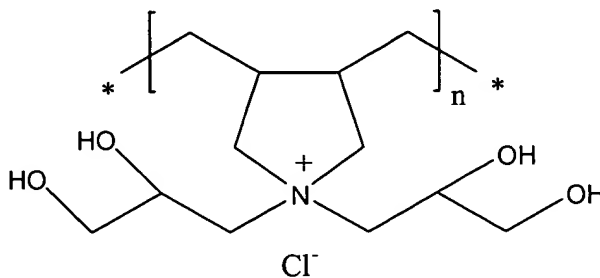
Where, however, the classification is the same and the field of search is the same and therein is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. MPEP 808.02.

The Examiner has identically classified the claims of Groups V and VI in Class 424, in the same subclasses, i.e., Subclasses 78.31, 78.35, 78.36, 78.38 and 78.12. There is no reason to believe that the classification or the field of search will change in the future.

The core structure of the polymers of Groups V and VI includes a five-membered, nitrogen-containing ring fused to the polymer backbone. The structures of the repeat units of the polymers recited in Group V (Claims 42 and 56) are shown below:

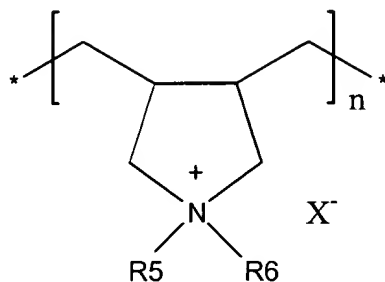


Claim 42



Claim 56.

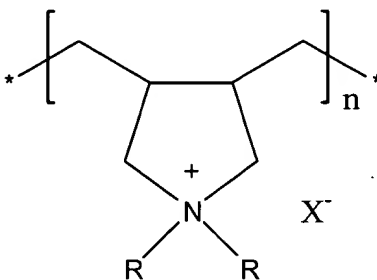
R5 is H or an alkyl chain from C₁ to C₂₂. The structure of the repeat units of the polymer recited in Group VI (Claim 49) is shown below:



Claim 49.

R5 is H or an alkyl chain from C₁ to C₂₂ and R6 is H or an alkyl chain from C₁ to C₂₂. The only difference between the polymers of Group V and Group VI is in the substituents attached to the nitrogen atom in the five-membered ring. R5 and R6 in Claim 49 are H or a C₁ to C₂₂ alkyl group. One or both of the corresponding substituents in the polymers recited in Claims 42 and 56 are required to be dihydroxyalkyl.

Based on these structures, the Examiner could simultaneously search the claims of Groups V and VI using the following structure:



where R is selected from the group consisting of H or a C₁ to C₂₂ alkyl group optionally substituted with two hydroxyl groups. Applicants expect that this search will show the claims of Groups V and VI are novel and unobvious, so there is no need to conduct separate searches for Groups V and VI.

Because of the structural similarity of the polymers of Groups V and VI and the fact that a *single search* is adequate to examine both groups of claims, Applicants maintain that the Restriction Requirement is improper. According to MPEP 803, claims drawn to independent and distinct inventions should be examined when there is no additional search burden on the

examiner. Applicants thus petition that the Restriction Requirement of Groups V and VI be withdrawn, and the claims of these groups be recombined.

Please charge any fees that may be due in this matter to Deposit Account No. 08-0380.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Jesse A. Becker
Jesse A. Becker
Registration No. 52,883
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, Massachusetts 01742-9133

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